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Application Serial No. 10/723,040

REMARKS

The Examiner rejected all pending claims. Applicant hereby amends claims 1, 22 and 42 to more clearly define the inventive subject matter.

In a previous Office Action dated March 14, 2006, the Examiner objected to the drawings. In response, the Applicant submitted a set of replacement drawings with the amendment filed on May 17, 2006. In the present Office Action, the Examiner did not acknowledge receipt of the replacement drawings or indicate whether the replacement drawings have been accepted. Applicant respectfully requests that the Examiner indicate receipt and acceptance of the replacement drawings with the next correspondence to the Applicant.

The Examiner rejected claim 1, 22 and 42 on non-statutory obviousness-type double patenting over claims 1, 12 and 15 of U.S. Patent No. 6,714,793. Although for the record Applicant respectfully disagrees with the Examiner's position that the claims of the Patent anticipate the pending claims or render the pending claims as an obvious variant of the invention defined therein, in the interest of moving the prosecution forward in a constructive manner, Applicant encloses a terminal disclaimer herewith.

The Examiner rejected claims 1-61 under 35 U.S.C. 101 as lacking patentable utility. Applicant respectfully traverses this rejection. The Examiner states "the claim[s] fail to produce according to all possible scenarios a 'specific machine to produce a useful, concrete, and tangible result'." In the remarks section of the amendment filed on May 17, 2006, the Applicant respectfully noted that the Examiner fails to provide a "full development of the reasons [for such

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rejection] rather than a mere conclusion coupled with some stereotyped expression," as required by MPEP 706.03. Specifically, the Examiner failed to offer any explanation of what claims fail to produce "a useful, concrete, and tangible result," or why not. In response, the Examiner has added one sentence to the rejection. This sentence states "Presently the computer does not produce a tangible result the entire processing is done within a single computer and therefore no tangible result is created" (sic). Applicant respectfully notes that the patent law does not equate production of a tangible result with the performance of processing by more than one computer. There is no prohibition in 35 U.S.C. § 101, or in the rules or case law thereon, barring claims that recite processing by a single computer. Therefore, the Examiner is not allowed to reject claims under 35 U.S.C. § 101 because all processing in a claim is performed by a single computer, but only because the pending claims lack patentable utility as defined by the statute, rules and case law.

For at least the following reasons, the invention as recited by the pending claims does produce a useful, concrete, and tangible result under all circumstances. Claim 1 recites "receiving an electronic message addressed to a telephone number...determining in real time whether an instant message receiver is currently available to receive messages addressed to the instant message identifier...and [either] forwarding the electronic message as an instant message... to the instant message identifier...[or] sending the electronic message to a mobile device at the telephone number" based on whether or not an instant message receiver is currently available. This is a useful, concrete, and tangible

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result, produced under all circumstances. The method will either forward the electronic message to an instant message receiver or to a mobile device, depending upon whether an instant message receiver is available. Either way, a tangible useful result occurs: an electronic message is transmitted to a desired target. The method is concrete in that depending upon a specific determination (whether an instant message receiver is currently available), the method will execute one step or the other (send message to instant message receiver or send message to mobile device).

Claims 2-21 dependent from claim 1 and are thus useful for at least the same reasons as claim 1. Claims 22-41 are apparatus claims similar in scope to claims 1-21, and are thus useful for at least the same reasons as claims 1-21. Claims 42-61 are program storage medium claims similar in scope to claims 1-21, and are thus useful for at least the same reasons as claims 1-21.

Applicant respectfully requests that the Examiner withdraw the 35 U.S.C. 101 rejection, or provide a "full development of the reasons [for such rejection] rather than a mere conclusion coupled with some stereotyped expression," as required by MPEP 706.03.

The Examiner rejected claims 1-61 under 35 U.S.C. 102 as being anticipated by Mache. Applicant respectfully traverses this rejection. Claim 1 as amended recites "receiving an electronic message addressed to a telephone number...determining in real time whether an instant message receiver is currently available to receive messages addressed to the instant message identifier...and [either] forwarding the electronic message as an instant

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message... to the instant message identifier...[or] sending the electronic message to a mobile device at the telephone number" based on whether or not an instant message receiver is currently available. In other words, a received electronic message is sent either to an instant message receiver or a mobile device, based on whether an instant message receiver is currently available to receive an instant message. More specifically, claim 1 recites receiving an electronic message that is addressed to a telephone number, locating an instant message identifier associated with that telephone number, and determining in real time where to send the message depending upon whether an instant message receiver is currently available to receive instant messages sent to the instant message identifier associated with the telephone number. If so, the electronic message is sent to the instant message receiver. If not, the electronic message is sent to a mobile device at the telephone number. Thus, when a user is currently available to receive instant messages, incoming messages are sent to the user; when the user is unavailable, the messages are routed to the user's mobile device (e.g., cell phone).

The above described limitations are neither disclosed nor suggested by Mache. Instead, Mache describes receiving a message in any format, and translating the message into a universal format (UIM) for routing through a network. The message is then converted into a device appropriate format based on the target recipient, and routed to the appropriate device. See [0035]-[0039]; [115]. Thus, an incoming message addressed to an instant message receiver would presumably be sent to the instant message receiver, and an incoming

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message addressed to a mobile device would presumably be routed to the mobile device, but nothing in Mache discloses or suggests determining whether an instant message receiver is available at all, much less sending an individual message to an instant message receiver or a mobile device at a telephone number depending upon whether the target user is available to receive instant messages.

The Examiner suggests, without explanation, that Mache discloses determining whether an instant message receiver is available to receive instant messages at [51]. In the remarks section of the amendment filed on May 17, 2006, the Applicant respectfully pointed out that nothing in [51] or elsewhere in Mache mentions or hints at determining whether an instant message receiver is available to receive instant messages, as recited by claim 1. Applicant further pointed out that as making such a determination is not disclosed, it follows that Mache does not disclose sending a message to A) an instant message receiver or B) to a mobile device associated with a telephone number, based on the results of said determination.

In response, the Examiner stated that Applicant professed a lack of understanding of Mache. The Examiner then suggested that Applicant read Mache in its entirety. For the record, Applicant stated that Mache does not suggest the recited limitation, not that Applicant does not understand Mache. Applicant assures the Examiner that he has read Mache in its entirety.

In response to the Applicant's assertion that Mache fails to disclose determining whether an instant message receiver is available to receive instant

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messages, the Examiner also cited a number of sections of Mache that allegedly disclose "the routing of messages" and "the state of the device information, which is used to determine the routing of messages." Applicant respectfully notes that determining message routing is not equivalent to "determining in real time whether an instant message receiver is currently available to receive instant messages," as recited by claim 1. Applicant further notes that Mache's determination of message routing comprises determining the physical transfer media over which to route messages. This is in no way equivalent to the recited determination of *where* to send the message. Mache's determination of "transfer media" comprises making a choice as to which medium to use in order to transmit a message to whatever its destination happens to be. The relevant limitation of claim 1, on the other hand, recites determining to where to send an individual message targeted to a user, not over which media to transport the message. Furthermore, Mache does not suggest or disclose determining which "transfer media" to use based on the currently availability of a user, but instead "depending upon the target network, the message type and/or client preferences contained in the client database." [20].

These distinctions are substantive. Mache enables transmitting messages between sources and destinations of varying formats by using a common internal message format. Applicant's invention as recited by claim 1 concerns determining whether to send an individual message addressed to a specific target to an instant message receiver or a mobile device associated with a telephone number, based upon whether the user is currently available to receive

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instant messages. These are different problems, and as explained above they are solved in different ways, through the use of different mechanisms and methodologies.

Claims 2-21 dependent from claim 1 and are thus novel for at least the same reasons as claim 1. Claims 22-41 are apparatus claims similar in scope to claims 1-21, and are thus novel for at least the same reasons as claims 1-21. Claims 42-61 are program storage medium claims similar in scope to claims 1-21, and are thus novel for at least the same reasons as claims 1-21. Although moot in light of the above, for the record Applicant respectfully traverses the Examiner's assertion that the additional recited limitations of the dependent claims are anticipated by Mache.

Applicant respectfully posits that all objections to and rejections of the pending claims have been overcome. Accordingly, Applicant respectfully requests allowance of all claims as amended. If the Examiner would like to discuss this matter, Applicant's attorney can be reached at 650-474-8400.

Respectfully submitted,



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